

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL J. BRYAN



Appeal No. 2006-1536¹
Application No. 09/871,349
Technology Center 3700

ON BRIEF

Before FRANKFORT, BAHR and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under 37 CFR § 41.50(a) for appropriate action with regard to the items indicated below.

¹ It is noted that this appeal was scheduled for an oral hearing on June 8, 2006. However in light of the noted procedural deficiencies of the application, Administrator Feinberg notified Appellant's representative that the panel decided to remand the case to the examiner. It was agreed that the oral hearing would be rescheduled when the examiner returns the case to the board in proper form for appeal.

First Issue.

On November 24, 2004 the examiner issued an office action rejecting claims 1 through 5, 7 through 11 and 13 through 15 under 35 U.S.C. 103 as being unpatentable over Elrod (U.S. Patent 4,998,736) in view of *Ex. Parte Breslow* or *In re Ngai* or *In re Gulack*. (See Office action dated, 11/24/04, pp 2-5). Further, in the office action the examiner rejected claim 6 under 35 U.S.C. 103 as being unpatentable over Elrod (U.S. Patent 4,998,736) in view of *Ex. Parte Breslow* or *In re Nagi* or *In re Gulack* and Hunsberger (U.S. Patent 6,279,908). (Office action dated 11/24/04, p4). Appellant filed an appeal brief on March 28, 2005 which addressed these rejections and presented arguments rebutting the rejections, these arguments grouped the claims into four (4) separate groups. (Brief, pp 4-17). Concurrent, with the filing of the Brief, Appellant submitted, under 37 C.F.R. 1.132, a declaration of Paul Bryan. We find no indication in the Examiner's answer that the Examiner considered this declaration. Thus, we remand the case to the examiner to determine if the Declaration was properly submitted under 37 C.F.R. 41.33(d) and if so to consider the Declaration.

Second Issue.

The Examiner's answer: does not identify Hunsberger as evidence relied upon in rejecting the claims; does not restate the rejection of the claims and does not respond to Appellant's arguments directed to each of the group of claims. As such it is not clear from the record if the examiner maintained the rejection of claim 6. Accordingly, we remand the application to the examiner to a) properly identify all of the art relied upon in rejecting the claims, b) restate the rejection identifying which art is applied to which claim, and c) respond to Appellant's arguments.

It is noted that Appellant raised both of the above issues in the Reply Brief, filed August 15, 2006. (See Reply Brief, pp 6-7). The examiner did not address these issues in the October 28, 2005 letter acknowledging the reply brief.

Thus, we REMAND the application to the examiner to clarify the issues noted *supra*. The examiner may comply with this remand by either a supplemental examiner's

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answer responsive to the above-noted issues or if appropriate by re-opening prosecution to address the above noted issues. It follows that Appellant should have an opportunity to respond to any such supplemental answer by way of a further reply brief or via other action as provided in 37 CFR § 41.50(a)(2).

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 3, August 2005.

REMAND


CHARLES E. FRANKFORT
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

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Coats & Bennett, PLLC
P.O. Box 5
Raleigh, NC 27602